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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,619

Applicant(s)

TSUJINO, NOBUAKI

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-24 is/are rejected.
- 7) ☒ Claim(s) 9-14 and 25-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/02/03 & 6/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS - mail date 7/7/04.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On page 10, line 18, "sheer" should be replaced with "sheet".

On page 18, line 26, "biding" should be replaced with "binding".

Appropriate correction is required.

Claim Objections

2. Claim 15 is objected to because of the following informalities: in line 8 "sheer" should be replaced with "sheet". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, lines 5-6, it is not clear what is meant by "...and the above-mentioned a pair..."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8, 17, 18 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsh (WO 01/43980).

Hirsh discloses a file binder organizer wherein a binding member (1) constituting a ring-shaped body to file papers (5) is mounted on a cover sheet body (as seen in figure 1), characterized by a pair of hinges being arranged at predetermined positions of the ring-shaped body (on page 13, lines 8-9, Hirsh disclose ring chips 2, 3 being hinged to the body 1; inherently, they would be hinged at a predetermined position) and a portion ahead of the hinge of the ring-shaped body can be inclined (as seen in figure 8).

Regarding claim 2, the ring-shaped body comprising a pair of openable and closable ring chips (2, 3) and each distal end portion of the ring chips being engaged to close a space between the ring chips (as seen in figure 7), and first and second hinges being arranged on the ring chips and an engagement arrangement to engage the distal end portions of the ring chips (as seen in figure 7).

Regarding claim 8, the file binder comprises a stopper to retain an angle of the hinge (the connection between the ring chips and the body would have a stopper).

Regarding claim 17, see the above rejections to claim 1.

Regarding claim 18, see the above rejections to claim 2.

Regarding claim 24, see the above rejections to claim 8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsh.

Regarding claim 15, Hirsh discloses the file binder includes a rear cover sheet, a scroop (7) and a front cover sheet (as seen in figure 7). However, Hirsh discloses the claimed invention except for the distance of the hinges from the inner face of the rear cover sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required distance for the hinges, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 16, the file binder includes a rear cover sheet, a scroop (7) and a front cover sheet (as seen in figure 7) and an opening allowing a portion ahead of the hinge to pass (as seen in figure 8). However, Hirsh fails to disclose the binding member being mounted on the rear cover sheet, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the binding member at any desired location of the file

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binder, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, applicant has failed to disclose that the location of the binding member is critical to the invention.

9. Claims 3-7 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsh in view of Kaneda (6,761,497).

Regarding claims 3 and 19, Hirsh discloses the claimed invention except for the claimed engagement arrangement of the ring chips.

Kaneda discloses a loose leaf binder comprising a ring-shaped body (1,2) having first (3) and second (4) half-rings. Half-ring (3) comprises a distal end portion having an axial hole (as seen in figure 4a) and the half-ring (4) comprising a distal end portion having a projection portion (as seen in figure 5a), wherein the axial hole of the half-ring (3) accommodates the projection portion of the half-ring (4) (as seen in figures 2 and 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hirsh's invention to include an engagement arrangement, as taught by Kaneda, to enable a secure closure between the ring chips.

Regarding claims 4 and 20, the notch being formed by cutting off at least a part of an inner face of the axial hole so that an opening edge of the axial hole expands toward a direction to which the ring chips open or close does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the

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manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 5 and 21, the projection portion being treated to be sphere does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 6, 7, 22 and 23, Hirsh disclose the claimed invention except for the projecting ends of the ring chips being a partial sphere shape. It would have been an obvious matter of design choice to make the different portions of the projection ends of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Allowable Subject Matter

10. Claims 9-14 and 25-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose notebooks, binders and the like.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 19, 2004


MONICA S. CARTER
PRIMARY EXAMINER